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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,218	07/19/2002	Peter Cole Goodwin	131279-1016	9610
60148 7590 08/07/2008 GARDERE / JAMES HARDIE GARDERE WYNNE SEWELL, LLP 1601 ELM STREET SUITE 3000 DALLAS, TX 75201				
EXAMINER MARCO ANTONI, PAUL D				
ART UNIT 1793		PAPER NUMBER		
MAIL DATE 08/07/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/070,218

Applicant(s)

GOODWIN ET AL.

Examiner

Paul Marcantoni

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2008 and 28 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 14-16, 18, 19, 22 and 52-80 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 52-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 14-16, 18, 19, 22, 79 and 80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 12, 14-16, 18, 19, 22 and 52-80 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-846)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant's arguments filed 4/11/08 (and comments in petition to revive-approved from 5/28/08) have been fully considered but they are not persuasive.

Non-Elected Claim:

Claim 20 is non-elected based on applicants own election of a specific viscosity enhancing agent. First applicants counsel elected Group II, claims 12-22. Note that the examiner did not make an election of species requirement but the applicants (Linda Liu-Registration No. 51,240-Knobbe Martens, Olson, Bear, LLP) did state the following on page 4 of her 9/23/04 response to the examiner's 3/19/04 restriction requirement:

The Applicant also hereby elects cellulose ether (claim 17) as the species for viscosity enhancing agent and withdraws claim 20 from consideration. While the law firm handling this application is now different as is the individual attorney, her election is still authorized and binding. The applicants made their own election of species without the examiner's requesting it so claim 20 remains non-elected until the species of cellulose ether is found allowable. So far it has not been found allowable so there is no need to rejoin or search for the other species of viscosity enhancing agents as is proper with any election of species requirement.

Non-Elected by Original Presentation:

Applicants' submission of new method claims 52-78 are non-elected by original presentation as applicants original claims were only directed to the product or composition. Method claims are a new statutory class of invention and are thus withdrawn from consideration.

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New Matter:

Claim 12, 79, and 80 are rejected under the first paragraph of 35 USC 112 and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed.

The new matter of claim 12 remains. Applicants add the same limitation to claims 79 and 80 (less than 0.2 % by wt) and these are new matter thus as well.

The terms "to less than 0.2%" by weight of (dry solid...) of sulphonated dispersion agent is new matter. There is no literal support for "to less than 0.2% from the original disclosure.

The applicants addition of new claims 79 and 80 also resulted in the following new new matter rejection. The range of "3-5% by wt. of a cellulose ether is new matter because there is no literal support for the lower limit range of "3" wt%. Please see the previous discussion and explanation regarding Wertheim. The same situation applies here.

35 USC 102:

Claims 12,14-16, 18-19, 22, 79, and 80 are anticipated under 35 USC 102(b) over Valore '231 or Sobolev et al. '289 B2.

See previous office actions for further analysis.

35 USC 103 :

Claims 12,14-16, 18-19, 22, 79, and 80 are rejected under 35 USC 103(a) as obvious over Hayakawa et al. '086, Valore '231, or Sobolev '289 B2 alone or in view of Downing et al. '199.

The rejections are the same as in the previous final rejection and more detailed analysis of each reference can be found in that office action. The only revision over the final rejection is that Hayakawa et al. '086 is now a primary reference (this was also discussed in applicants' specification). Hayakawa does not teach the addition of a dispersant or dispersing agent such as a sulfonated dispersant. Yet, the addition of a dispersant to cement compositions is a conventional additive to cement and its addition would have been an obvious design choice for one of ordinary skill in the art. The applicants are also referred to their original disclosure and it teaches on page 6 sulfonated dispersants but also non-sulfonated dispersants (See list in lines 24-28, second to last paragraph). Thus, applicants only difference over the Hayakawa reference is adding a dispersant; a common and conventional additive to cement. Downing et al. '199, nevertheless, teach that adding a dispersing agent to a cement is conventional in the art (col.1 last line and col.2, lines 1-24).

Response to Remarks included in 9/18/07 RCE:

Valore:

Applicants allege that in light of their amendment to less than 0.2% for sulfonated dispersing agent, Valore no longer applies. Valore teaches a minimum amount of dispersant in his cement composition of 0.2%. In rebuttal, applicants' amendment is

new matter not literally supported by original disclosure. The applicants provide no examples for 0.2% or even less than this amount over a range of data points to support this newly added limitation. The applicants only have the teaching of the broad range and the endpoints.

Sobolev et al:

Sobolev, like Valore, has been maintained in the rejection because applicants amendment of "less than 0.2% is new matter.

Response to 4/11/08 Applicant Remarks:

Claim 20 has been rejoined or now added as a rejected claim. Regarding the new matter rejection, the examiner maintains there is no literal support for –to less than 0.2 % by wt. Applicants appear to amend to this numerical value simply to get around his prior art references when they have no literal support in any example, claim or statement in their original disclosure. Wertheim (1976) contrary to applicants' assertions does not give applicants the flexibility to amend in this manner. In Wertheim, there was literal support for the broad range of 25-60% from the original disclosure and specific embodiments 36% and 50% for the CCPA to hold the claimed lower limit range of 35% (note 36% is about 35%) was supported and not new matter. In the applicants' situation, they only teach a range of 0.05 to 0.5 wt% for the amount of dispersion agent. The applicants appear to take less than 0.2% to amend around the prior art when Wertheim did no such thing. Possibly if

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applicants claimed 0.4 wt% it would follow Wertheim but they make a leap from 0.5 wt% to 0.2 wt%. Note also that Wertheim (unlike applicants) nearly had literal support (36% vs 35%) for their lower limit range. Applicants have no such literal support and thus cannot invoke Wertheim because it is not similar at all. The applicants are also violating the intentions of the CCPA who stated in Wertheim that "we wish to make it clear that we are not creating a rule applicable to all description requirement cases involving ranges." This is not a rule and the CCPA is telling future applicants not to apply this standard in the same manner. Nevertheless, the situations are not the same as already discussed above. The new matter rejection is proper and sustained.

Sobolev and Valore:

Applicants again repeat arguments which hinge on their new matter range addition. The examiner maintains this is new matter and it is not convincing over the prior art for this reason.

Hayakawa:

The applicants argue a range "less than 0.2%" for sulphonated dispersant which they have no support for from their original disclosure for Hayakawa. It is improper to argue a limitation which has no original support and is new matter. Also, the applicants' previously claimed range of amount of dispersant of 0.05 to 0.5% (the originally claimed applicant range and that having literal support from their specification as well) by weight is within the amount of dispersant that is

conventional in the art. Note that applicants acknowledge that the addition of dispersants to a cellulose fiber cement composition is conventional in the art. They even state that the examiner may be correct in adding dispersants as old in the art for cellulose fiber cement. The word *may* is misapplied because the examiner *is* correct. Dispersants are notoriously known as additives to cements as are thickening agents such as celluloses and the applicants surprising synergy between viscosity enhancing agents and dispersing agents is not so surprising because both are conventional additives to cements and can be added together.

The following prior art references have been cited to show that the alleged synergistic use of a dispersion agent or dispersant and a viscosity enhancing agent (e.g. cellulose) or thickener is old and conventional in the art for extrudable cement compositions. These have been cited as relevant and are not used in the rejection. The prior art in the rejections above sufficiently teach applicants' invention:

McCurich et al. (US 4,131,480) teach mixing methyl cellulose (viscosity enhancing agent) and a sulfonated dispersant such as sulfonated melamine and though it is used to improve pumpability this property is related to extrusion itself (See claims).

Li et al. (US 6,809,131 B2) teach extrudable compositions comprising dispersant and cellulose for cements. Should their ever be a possible interference with this reference and applicants' invention, the examiner who allowed the first interfering application rightfully get the interference. Mr. Peter Szekely would thus be the *appointed* examiner in any interference should that happen since he allowed first.

Anderson et al. (US 5,658,624) teaches extruding cement articles. Anderson teaches that his extrudable cement comprises rheology modifying agents (e.g. cellulose-see col.8, last paragraph and col.9, line 11) and dispersants (col.8, line 66) and that the suitable dispersants include any material which can adsorb onto cement or hydraulic binder and disperse the particles (see col.9, lines 30-33). Thus even sulfonated dispersants are inclusive of "any" dispersant that can be mixed with a rheology modifier such as cellulose. It can be seen by Anderson alone that the synergistic effect allegedly discovered by applicants is not new and is thus old and conventional in the art. (ie mixing dispersant and viscosity enhancer such as cellulose for extrudable cement).

Anderson et al. (US 5,549,859) teach the same as Anderson '624 (see claims of '859 as well).

Hayakawa (JP 07033502 abstract) teach extrudable cements comprising sulfonate dispersant and cellulose (viscosity enhancer). This thus teaches applicants invention.

Sanuki (JP 06144911 abstract) teach a composition comprising an extrudable cement (see abstract).

Tsugi (JP 06001648 abstract) teaches an extrudable cement comprising cellulose and sulfonic acid condensate dispersant (see abstract).

Tanaka et al. (JP 62036056 abstract) teach an extrudable cement comprising sulfonate dispersant. The use of a sulfonate dispersant in an extrudable cement composition is thus conventional and old in the art.

Tanaka et al. (JP 62036055 abstract) teach an extrudable cement comprising cellulose and sulfonate dispersant (see abstract).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Marcantoni/
Primary Examiner, Art Unit 1793